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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,343	12/28/2001	Dennis McDevitt	9417.17584-CIP	8332

7590

08/23/2004

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EXAMINER
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ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/034,343	Applicant(s) MCDEVITT ET AL.	
	Examiner Eduardo C. Robert	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,8,9 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1,2,6 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 2, 2004 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, lines 9-10, "without rotation of the pins within the stems" is new matter. It is noted that the specification as original filed does not disclose that the stems are expand without rotation of the pins within the stems.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (U.S. Patent 5,108,446).

Wagner et al. disclose an implant comprising a base 1 including at least one stem 3 capable of engaging one void created in a bone structure. The stem 3 having an exterior peripherally surrounding an interior lumen. The implant also has a pin 7 that fits into the interior lumen and expands the exterior of the stem 3 (see Figure 3). The implant also has a cap 2 from which the pin 7 depends, wherein fitting the pin 7 into the interior lumen of the stem couples the cap to the base. The cap has a bearing surface and the pin 7 depends from the cap from a surface that faces away from the bearing surface (see Figure 3). The arrangement of the pin 7 is complementary to the arrangement of the stems and alignment of the pin with the stem aligns the base with the cap (see Figure 3). The cap and base include nesting surfaces that rest together when the base is coupled to the cap (see Figure 3). The stem is adapted to expand within the bone to compresses surrounding bone structure (see Figure 3). Wagner et al. disclose the claimed invention except for the base having a plurality of stems and complementary plurality of pins. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Wagner et al. having a plurality of stems and pins, since it has been held that mere duplication of the essential working parts of a device involves only routine

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skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. With regard to the functional limitations of claim 1, which is considered new matter, it is noted that the device of Wagner et al. has the ability, i.e. it is capable, of having the stems expand without rotation of the pins within the stems, e.g. the pins need only to be pushed into the stems.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. (U.S. Patent 5,108,446).

Wagner et al. disclose an implant comprising a base 1 including at least one stem 3 capable of engaging one void created in a bone structure. The stem 3 having an exterior peripherally surrounding an interior lumen. The implant also has a pin 7 that fits into the interior lumen and expands the exterior of the stem 3 (see Figure 3). The implant also has a cap 2 from which the pin 7 depends, wherein fitting the pin 7 into the interior lumen of the stem couples the cap to the base. The cap has a bearing surface and the pin 7 depends from the cap from a surface that faces away from the bearing surface (see Figure 3). The arrangement of the pin 7 is complementary to the arrangement of the stems and alignment of the pin with the stem aligns the base with the cap (see Figure 3). The cap and base include nesting surfaces that rest together when the base is coupled to the cap (see Figure 3). The stem is adapted to expand within the bone to compresses surrounding bone structure (see Figure 3). Wagner et al. disclose the claimed invention except for the base having a plurality of stems and complementary plurality of pins and the pins and stems having a triangular configuration which correspond to each other. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Wagner et al. having a plurality of stems and pins, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the

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art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the implant of Wagner et al. with the pins and stems having a triangular configuration which correspond to each other, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of orienting the pins and/or stems. In re Dailey and Eilers, 149 USPQ 47 (1966).

### ***Response to Arguments***

Applicant's arguments filed on July 28, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Wagner et al. do not disclose expanding the exterior of the stems without rotation of the pins within the stems, it is noted that this recitation is new matter. Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The structure of the implant of Wagner et al. has the ability to perform the function is one so desire, e.g. the exterior of the stems could be expanded by pushing the pins into it.

In response to applicant's argument that Wagner et al. do not disclose a plurality of stems in a triangular configuration, applicant's attention is directed to the 103 rejection of claim 15 above. Furthermore, applicant's specification clearly discloses that the orientation of the stems with respect to each other is not critical (see applicant's specification page 6, lines 32-33).

***Allowable Subject Matter***

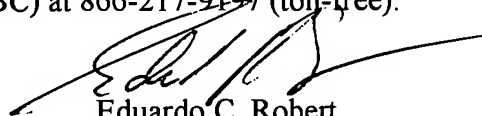
Claims 8 and 9 are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.